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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,480	09/22/2003	Yuichi Atarashi	5341-17	2925
27799 7590 04/27/2009 COHEN, PONTANI, LIEBERMAN & PAVANE LLP 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176				
EXAMINER				
KHAN, USMAN A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/668,480

Applicant(s)

ATARASHI ET AL.

Examiner

USMAN KHAN

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 25-30 and 37-40 is/are pending in the application.
- 4a) Of the above claim(s) 8-16, 25-30 and 37-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 45-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/17/2008.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/13/2009 has been entered.

Response to Arguments

2. Applicant's arguments filed on 02/13/2009 with respect to claims 1 and 9 have been considered but are moot in view of the new ground(s) of rejection.

DETAILED ACTION

Double Patenting

3. Claims 48 and 49 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 45 and 46 (Note: dependent claims 45, 46, 48, and 49 all depend on independent claim 1). When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 and 45-49 are rejected under 35 U.S.C. 102(b) as being anticipated by MIYAKE (EPO Patent NO. EP1148716A1).

Regarding **claim 1**, MIYAKE teaches an image pickup device comprising:

- (a) a base board on which an opening portion is formed (figures 1 and 2A, item 1 with opening 1A);
- (b) an image pickup element provided on a reverse surface of the base board so that at least a part of the opening portion is covered (figures 1 and 2A item 2);
- (c) an optical member (figure 1 items 3 and 3a in combination) including a lens portion (figure 1 item 3a) to form an image of an object onto the optical pickup element (figures 1, 4B, 5, and 8-10), a leg portion to support the lens portion (figures 1, 4B, 5, and 8-10 item 3; the examiner can broadly consider the sides of item 3 as a leg portion), and a contact portion to be brought in contact with the image pickup element (figures 1, 4B, 5, and 8-10; item 3 bottom and item 2 contact each other), the optical member configured for converging light incident on the image pickup element (figures 1, 4B, 5,

and 8-10), the optical member being provided so as to come in direct contact with a front surface of the image pickup element from the front surface of the base board through the opening portion (figures 1, 4B, 5, and 8-10; item 3 bottom and item 2 contact each other); and

(d) an outer frame member provided on the base board to cover the optical member and the opening portion (figures 12-13 item 9), an inner surface of the outer frame member being engaged with the optical member (figures 12-13 item 9), wherein the outer frame member is arranged at a prescribed position on the base board so that a center of a photoelectric conversion portion of the image pickup element agrees with a center of an optical axis of the lens portion of the optical member (figures 12-13 item 9).

Regarding **claim 2**, as mentioned above in the discussion of claim 1, MIYAKE in view of Kingsley et al. teach all of the limitations of the parent claim. Additionally, MIYAKE teaches that the optical member comprises a portion to be engaged that is fitted in the outer frame member to prevent that the optical member rotates about an optical axis of the optical member, and the outer frame member comprises an engaging portion that is fitted in the portion of the optical member (figures 12-13 items 3/3a/3c and 9 are engaged).

Regarding **claim 3**, as mentioned above in the discussion of claim 1, MIYAKE in view of Kingsley et al. teach all of the limitations of the parent claim. Additionally, MIYAKE teaches that the optical member comprises a first optical member that comes

in contact with a surface of the image pickup element (figure 1 item 3), and at least one auxiliary optical member which is stacked on the first optical member so that an optical axis of the auxiliary optical member agrees with an optical axis of the first optical member (figure 1 item 3a).

Regarding **claim 4**, as mentioned above in the discussion of claim 1, MIYAKE in view of Kingsley et al. teach all of the limitations of the parent claim. Additionally, MIYAKE teaches that the base board has electric parts thereon for processing an image (figure 2 item 1b circuit pattern; also figure 14 and paragraph 0061 page 9; ASIC OR DSP item 10).

Regarding **claim 5**, as mentioned above in the discussion of claim 1, MIYAKE in view of Kingsley et al. teach all of the limitations of the parent claim. Additionally, MIYAKE teaches that the prescribed electric parts are arranged on the base board that is covered by the outer frame member (figure 2 item 1b circuit pattern; also figure 14 and paragraph 0061 page 9; ASIC OR DSP item 10; also outer frame member figures 12-13 item 9).

Regarding **claim 6**, as mentioned above in the discussion of claim 4, MIYAKE in view of Kingsley et al. teach all of the limitations of the parent claim. Additionally, MIYAKE teaches that at least a part of the electric parts is arranged in the vicinity of a fixed position at which the outer frame member is fixed (figure 2 item 1b circuit pattern;

also figure 14 and paragraph 0061 page 9; ASIC OR DSP item 10; also outer frame member figures 12-13 item 9).

Regarding **claim 7**, as mentioned above in the discussion of claim 4, MIYAKE in view of Kingsley et al. teach all of the limitations of the parent claim. Additionally, MIYAKE teaches that a photoelectric conversion section is provided on the front surface at a position corresponding to the opening portion to convert incident light to an electric signal (figures 1, 4B, 5, and 8-10; item 2 with side closer to the opening of item 1), and the optical member is arranged to focus an object image by converging the incident light onto the photo-electric conversion section (figures 1, 4B, 5, and 8-10 item 3/3a focus light on item 2).

Regarding **claim 45**, as mentioned above in the discussion of claim 1, MIYAKE in view of Kingsley et al. teach all of the limitations of the parent claim. Additionally, MIYAKE teaches that the optical member is a single-piece structure including the lens portion, the leg portion, and the contact portion (figure 1 items 3 and 3a in combination; where legs are the sides of item 3 and the contact portion is the bottom of item 3).

Regarding **claim 46**, as mentioned above in the discussion of claim 1, MIYAKE in view of Kingsley et al. teach all of the limitations of the parent claim. Additionally, MIYAKE teaches a pressure member which presses the optical member toward the base board (figures 5, 8 10A, and 12 item 5; Also item 9 item 6).

Regarding **claim 47**, MIYAKE teaches an image pickup device comprising:

(a) a base board on which an opening portion is formed (figures 1 and 2A, item 1 with opening 1A);

(b) an image pickup element provided on a reverse surface of the base board so that at least a part of the opening portion is covered (figures 1 and 2A item 2);

(c) an optical member (figure 1 items 3 and 3a in combination) including a lens portion (figure 1 item 3a) to form an image of an object onto the optical pickup element (figures 1, 4B, 5, and 8-10), a leg portion to support the lens portion (figures 1, 4B, 5, and 8-10 item 3; the examiner can broadly consider the sides of item 3 as a leg portion), and a contact portion to be brought in contact with the image pickup element (figures 1, 4B, 5, and 8-10; item 3 bottom and item 2 contact each other), the optical member configured for converging light incident on the image pickup element (figures 1, 4B, 5, and 8-10), the optical member being provided so as to come in contact with a front surface of the image pickup element from the front surface of the base board through the opening portion (figures 1, 4B, 5, and 8-10; item 3 bottom and item 2 contact each other); and

(d) an outer frame member provided on the base board to cover the optical member and the opening portion (figures 12-13 item 9).

Regarding **claim 48**, as mentioned above in the discussion of claim 1, MIYAKE in view of Kingsley et al. teach all of the limitations of the parent claim. Additionally,

MIYAKE teaches that the optical member is a single-piece structure including the lens portion, the leg portion, and the contact portion (figure 1 items 3 and 3a in combination; where legs are the sides of item 3 and the contact portion is the bottom of item 3).

Regarding **claim 49**, as mentioned above in the discussion of claim 1, MIYAKE in view of Kingsley et al. teach all of the limitations of the parent claim. Additionally, MIYAKE teaches a pressure member which presses the optical member toward the base board (figures 5, 8 10A, and 12 item 5; Also item 9 item 6).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to USMAN KHAN whose telephone number is (571)270-1131. The examiner can normally be reached on Mon-Fri 6:45-3:15.
6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on (571) 272-3022. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Usman Khan/
Usman Khan
04/21/2009
Patent Examiner

/Jason Chan/
Supervisory Patent Examiner, Art Unit 2622